

REMARKS

Introductory remarks

The present letter is filed in response to the Examiner's non-final Action of January 22, 2010. Currently pending claims 1, 24, 26-30, 32, 34, 35, and 40-49 have not been amended in view of the following arguments, which are directed to the patentability of independent claim 1.

35 USC 103 (Bourne in view of Garrison)

In the Action of January 22, 2010 the Examiner rejects claims 1, 27-28, 30, 32, 34 and 40-45 under 35 USC 103(a) as being unpatentable over US 2,948,174 to Bourne in view of US 2004/0006335 to Garrison. Applicant respectfully disagrees in view of remarks i) – v) below.

i) The device of Bourne 2,948,174 is a wrench. A wrench (i.e. a device that tightens or loosens metal nuts) is different from “*a surgical device apt to the removal of . . . tissues during surgery.*” Although the wording “*surgical device apt to the removal of . . . tissues during surgery*” is in the preamble of claim 1, such wording should be given patentable weight because is repeated in the body of claim 1. See the language “*for the removal of a tissue fragment*” or “*chassis of the surgical device*” inside the body of claim 1.

ii) Claim 1 recites a pair of “*side-by-side blades.*” According to the Examiner such blades are Bourne's elements 38 and 42. However, those elements are jaws, not “*blades.*”

iii) Bourne's jaws are not “*slidably coupled*” to each other because they do not slide one over/on the side of the other.

iv) Bell crank 98 in Bourne is not “*rotatably connected*” to jaw 42 and stem 92. In particular, bell crank 98 slides over surfaces 44 and 96, respectively. There is a rotatable (pivotable) connection concerning bell crank 98, but it is a connection 102 to the chassis, not to the jaw 42 and the stem 92.

v) bell crank 98's connection to the chassis 102 is not in a “*central position*” of such chassis.

Therefore, the Examiner has not made a prima facie 35 USC 103 against claim 1. Applicant submits that claim 1 is patentable over Bourne and Garrison, together with claims 27-28, 30, 32, 34 and 40-45 in view of their dependency on claim 1.

35 USC 103 (Bent in view of Bourne)

In the Action the Examiner further rejects claims 1, 24, 29, 35, 47 and 49 under 35 USC 103(a) as being unpatentable over Us 3,752,161 to Bent in view of US 2,948,174 to Bourne in view of US 2004/0006335 to Garrison. Applicant respectfully disagrees in view of remarks vi) – ix) below.

vi) Claim 1 recites “*a motion transmission member . . . rotatably connected at opposed ends thereof to [the] slidable blade and to the stem of [the] piston.*” In the action of May 13, 2008 the USPTO took the motion transmission member was embodied by Bent’s element 100. In a subsequent action (January 26, 2009), the USPTO changed its position and acknowledged that Bent was not disclosing a motion transmission member. In the current action (January 22, 2010), the USPTO changes its mind one more time and now states that element 40 in Bent is a motion transmission member. However, as noted in Bent column 4, lines 20-22, element 40 is the rearward section of blade 20 and is integral with blade 20.

vii) As a consequence, element 40 is not a motion transmission member between a slidable blade and a piston because it is part of the slidable blade.

viii) Even assuming, for the sake of argument, that element 40 is a motion transmission member, Bent clearly does not show a rotatable connection between forward section 20 and rearward connection 40. The Examiner acknowledges this last point and, in order to find the ‘missing’ rotation uses element 98 of Bourne and, in particular, its connections 97 and 99.

However, Applicant has already shown above that bell crank 98 in Bourne is not “*rotatably connected*” to jaw 42 and stem 92. In particular, Bourne’s bell crank 98 slides over surfaces 44 and 96, respectively. There is a rotatable (pivotable) connection concerning bell crank 98, but it is a connection 102 to the chassis, not to the jaw 42 and the stem 92.

ix) The Examiner is using the coupling 96-98-99 of Bourne to replace the coupling 114 (stem of piston) – 40 of Bent. However, as shown in Figure 3 of Bent, elements 114 and 40 are on the same line, while in Bourne the operating mechanism 54 and the lower jaw 42 (see Figure 2 of Bourne) are not on the same line. Therefore, introducing Bourne’s coupling 96-98-99 in Bent is a clear mechanical absurd and would render Bent inoperable for its intended purpose. See MPEP 2143.01.

Therefore, the Examiner has not made a prima facie 35 USC 103 against claim 1. Applicant submits that claim 1 is patentable over Bent and Bourne, together with claims 24, 29, 35, 47 and 49 in view of their dependency on claim 1. Patentability of claims 26, 46 and 48 also follows in view of the above arguments.

Conclusions

In view of the above arguments, reconsideration and allowance of the claims are respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 50-4194. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection herewith may be charged to deposit account no. 50-4194.

I hereby certify that this correspondence
is being electronically transmitted on

April 15, 2010

(date of deposit)

/Alessandro Steinfl/

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Respectfully submitted,

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